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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,275	07/11/2003	Ronald Paul Dean	10017961-2	4838

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EXAMINER

LE, TAN

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/618,275	Applicant(s) DEAN ET AL.	
	Examiner Tan Le	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the second office action for serial number 10/618,275. This application contains 24 claims numbered 1-24. Claims 17-20 were withdrawn.
2. Applicant's amendment to specification filed 5/5/05 to update the status of reference to serial No. 10/080,341 has been entered.
3. Applicant has presented amendments of claim 14 and 22-24 to correct the dependencies thereof in accordance with the renumbering of the claims is appreciated.
4. Applicant's proposes submitting a terminal disclaimer in compliance with 37 C.F.R. 1.321© if the obviousness-type double patenting rejection stands upon indication that the claims are allowable over the art is acknowledged. However, the double patenting rejection still remained until the terminal disclaimer is received.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 12-16, 21 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,666,414. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and the application are claiming common subject matter. All elements recited in the instant claims are also recited in claims 1-17 of Patent No. 6,666,414. Both set of claims are drawn to a mounting bracket for a device.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7, 10-11, 12-16 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,823,495 to Joss et al.

Regarding claim 1, Joss et al. teaches a mounting bracket for a device comprising: a deforming element (120) (Figs. 1-2) configured from a resiliently-deformable surface (104), wherein said deforming element increases a deformability of said resiliently-deformable surface; and a pair of attachment members (107) disposed on opposite sides of and attached to said surface and adapted to interface with the device upon deformation of said deforming element. Note that the surface (104) is inherently deformable since virtually anything will be deformed if enough pressure is applied to it. See *Fredman V. Harris-Hub Co., Inc*, 163 USPQ 397 (DC 1969).

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Regarding claim 2, said each of said attachment members comprises fastener attachment sites (112, 115) for receiving fasteners for interfacing said attachment members with the device upon deformation of said deforming element.

Regarding claim 3, said deforming element comprise one or more compression elements (120, 122).

Regarding claim 4, said deforming element comprises a substantially serpentine metal strip (120).

Regarding claim 5, said deforming element comprises a portion of said surface adapted to provide a spring element.

Regarding claim 6, said deforming element is adapted to provide linear deformation of said surface.

Regarding claim 7, said deforming element of said surface is compressed to bring said attachment members into contact with said device.

Regarding claims 10-11, Joss et al. also teaches a thermal interface material disposed between the attachment member and the device and the thermal interface material is a thermally-conductive elastomer sheet material (114, 115) (Col. 2, lines 5-54)

Regarding claim 12, said device is capable of holding a computer storage device. Note that this claim recites an intended use as set out in the preamble, which has given no patentable weight.

Regarding claim 13, said mounting bracket comprises screw holes defined in said attachment members.

Regarding claim 14, said resiliently-deformable surface is deformed by action of screws inserted through said screw holes into said device.

Regarding claim 15, said resiliently-deformable surface (104) comprises a compressible lateral midline portion connecting opposing outer lateral portions of said surface (108, 109 or 120).

Regarding claim 16, said resiliently-deformable surface includes a flat spring midline portion connecting opposing outer lateral portions of said surface (120).

Regarding claim 21, Joss et al. also teaches the device comprising: a mounting bracket constructed from a thermal conductor', sidewalls on said mounting bracket constructed from said thermal conductor; and fastening receptacles (112, 115) within said sidewalls for securing said device, wherein said fastening creates a thermal interface between said device and said sidewalls.

Regarding claims 22-23, Joss et al. also teaches a thermal interface material (114) disposed between the attachment member and the device and the thermal interface material is a thermally-conductive elastomer sheet material (114) (Col. 2, lines 5-54)

Claims 1-4, 6-9, 12, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,344,032 to Ramsdell.

Regarding claim 1, Ramsdell teaches a mounting bracket for a device comprising: a deforming element (20) configured from a resiliently-deformable surface wherein said deforming element increases a deformability of said resiliently-deformable surface; and a pair of attachment members (19) disposed on opposite sides of and attached to said

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surface and adapted to interface with the device upon deformation of said deforming element.

Regarding claim 2, said each of said attachment members comprises fastener attachment sites (18) for receiving fasteners (21) for interfacing said attachment members with the device upon deformation of said deforming element.

Regarding claim 3, said deforming element comprise one or more compression elements (walls 20 for example).

Regarding claim 4, said deforming element comprises a substantially serpentine metal strip.

Regarding claim 6, said deforming element is adapted to provide linear deformation of said surface.

Regarding claim 7, said deforming element of said surface is compressed to bring said attachment members into contact with said device.

Regarding claim 8, said deforming element is comprised of machined aluminum alloy.

Regarding claim 9, said attachment members are comprised of aluminum alloy (Col. 2, lines 5-20).

Regarding claim 12, said device is capable of holding a computer storage device. Note that this claim recites an intended use as set out in the preamble, which has given no patentable weight.

Regarding claim 21, Ramsdell also teaches the device comprising: a mounting bracket (19) constructed from a thermal conductor', sidewalls on said mounting bracket constructed from said thermal conductor; and fastening receptacles (18, 21) within said

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sidewalls for securing said device, wherein said fastening creates a thermal interface between said device and said sidewalls.

Regarding claim 24, said thermal conductor comprises aluminum alloy (see col. 2, lines 5-20).

Response to Arguments

7. Applicant's arguments filed 5/5/05 have been fully considered but they are not persuasive.

Applicant's argument with respect to claims 1-24 as pointed out on pages 7-9 are well taken but they are not persuasive. Examiner respectfully submits that both Joss and Ramsdell clearly teach the limitations as pointed out in the claims. The claims are therefore still rejected as being anticipated by Ross and/or Ramsdell.

The crux of Applicant's arguments are: (1) Joss does not teach or suggest a deforming element which increases a deformability of the resiliently-deformable surface (Remarks page 7, 3rd para); (2) There is nothing in the disclosure of Joss to teach or suggest that pads 114 is compatible with creating a thermal interface as recited in the claim; and (3) The elements of Ramsell relied upon in rejecting the claims are not arranged as recited in the claims (Remarks page 9, 1st para).

As to argument (1), the examiner remains his position that both Joss and Ramsdell clearly teach a deformable element, which can increase a deformability of the resiliently-deformable surface as pointed out in the office action. Furthermore, the examiner respectfully submits that the term "deformable" that "virtually everything will be

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deformed or flexed if enough pressure is applied to it". See *Fredman V. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969). In addition, the phrase beginning with "wherein" is merely a functional expression equivalent to "whereby" clause which does not define any structure and accordingly can not serve to distinguish and thus could not have patentable significance. The phrase beginning with "configured" also does not distinguish the claimed invention from prior art as how it can be configured or what may be configured in order to distinguish from the prior art.

As to argument (2), the examiner remains his position that the pads (114) constructed from "a compliant elastomeric material or any composition with desired damping properties is a potential candidate (See col. 2, lines 50-53), which in this case is clearly compatible with a thermal interface material as claimed by Applicant (see claims 10-11 for example) (thermally –conductive elastomer sheet material).

As to argument (3), Arguing that the elements of Ramsell relied upon in rejecting the claims are not arranged as recited in the claims is not persuasive. Examiner considers Ramsell teaches all elements as recited in the claims as pointed out in the office action. Applicant appears to emphasis the difference based on the intended use of the invention. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA

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1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case the mounting bracket of Joss or Ramsell is capable of dissipating heat in a computer mount device and the fastening receptacles within the sidewalls is capable of securing the computer-mounted device in relation to a computer, wherein the fastening capable of creating a thermal interface between the computer mounted device and the side walls.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (571) 272-6818. The examiner can normally be reached on Mon. through Fri. from 9:00 AM-6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
July 14, 2005.



ANITA KING
PRIMARY EXAMINER